

REMARKS

Claims 1-21 are pending in this application. Claim 13 is amended and claims 18-21 are added. Claims 1-12, 14, 15 and 17 have been withdrawn from consideration. It is respectfully request that the withdrawal be withdrawn.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Lugo in the November 15 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

In paragraphs 2-5, on pages 2-4 of the Office Action, a restriction/election requirement is provided that concludes with the requirement that Applicant must affirm the election made on September 7, 2004. Applicants affirm that election with traverse.

Firstly, claims 1-12, 14, 15 and 17 have been examined twice before in this application. The amendments made to claims 1, 4, 10 and 12 in the Amendment filed June 1, 2004, were not so extensive, nor did they raise issues that had not been previously raised, to require a restriction at this stage of prosecution. To require a restriction/election after twice considering the claims does not appear to be warranted and clearly creates an undue burden upon Applicant. Further, it is submitted that the claims that have been withdrawn, are sufficiently related to the claims remaining in the application that to consider one would entail considering the other. Therefore it is respectfully requested that the restriction/election requirement be withdrawn and prosecution proceed with all claims.

In paragraph 7, on page 4 of the Office Action, claims 13 and 16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamps.com as modified by Gottsman et al., U.S. Patent No. 6,134,548 (hereinafter "Gottsman") in view of Lemchen, U.S. Patent No. 6,594,642, and further in view of Harrington et al., U.S. Patent No. 6,161,099 (hereinafter "Harrington"). The rejection is respectfully traversed.

Applicants claim 13 is directed to an automated method of providing a personalized product in response to each request from customers, the automated method comprising the steps of receiving, by wireless communication, electronic personalized product producing data in a first format and customer identification information; electronically sequentially storing sets of the personalized product producing data and the customer identification information, each set including a piece of personalized product producing data and a piece of customer identification information; electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format; receiving the piece of data in the second format and recording the piece of data in the second format on an output medium used to produce a personalized product; producing the personalized product; and automatically notifying a customer of at least one of receipt of the electronic personalized product producing data and completion of the personalized product requested. None of the references, or their combination, fairly suggests such.

For a *prima facie* case of obviousness the claimed invention must be considered as a whole, the references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination, the references must be viewed without benefit of impermissible hindsight vision afforded by the claimed invention; and a reasonable expectation of success is the standard by which obviousness is determined (MPEP page 2100-120). Further, the "mere fact that references can be combined or modified does not render the result combination obvious unless the prior art also suggest the desirability of the combination," (In re *Mills*, 916 F.2d 680, 16 USPQ 2nd 1430 (Fed. Cir. 1990)).

The basic reference, Rubber Stamps, has been discussed several times during prosecution of this application. It discloses no method for providing personalized products in response to a request from customers, counter to what is alleged in the Office Action. Rubber

Stamps simply discloses a method of taking orders. While one could assume the personalized product is produced as a result of the order, or Rubber Stamps would be out of business, it does not discuss anything about how the information is stored or what is subsequently done with that data. In fact, the only thing it appears to disclose is the orders may be received telephonically, by facsimile or by e-mail.

The Office Action acknowledges that Rubber Stamps does not receive communications by wireless communication, does not electronically analyze each piece of electronic personalized product producing data in the first format and convert it into a piece of electronic data in the second format, does not receive the piece of data in the second format and record the piece of data in the second format on an output medium used to produce a personalized product; and does not automatically notify the customer of completion of a personalized product requested.

The Office Action then turns to Gottsman as teaching wireless communication. However, there is no indication that Rubber Stamps needs a fourth method of communication. Providing phone, assumedly to an operator on the other end, fax, or e-mail would appear to provide adequate communication means. Further, looking at the order form of Rubber Stamps, to input such a complex order into a wireless communication, such as described by Applicants, would appear to be excessive and would not be a desired way of requesting such a product. Thus, there is no motivation to combine Gottsman with Rubber Stamps.

Lemchen is applied as teaching an electronic data analyzer that receives customized data from a web server. The data is then converted into electronic data that the personalized product producing device receives in order to create the product. Again, this reference has been discussed previously. However, Lemchen teaches a device for producing products with the orders normally going through a middle-man, such as a service professional (col. 2, lines

27-39). The request is received through the web server 50 and translated into a set of machine instructions for the particular robotic machine, not recording the piece of data in the second format on the output medium used to produce the product.

Recording, as used in the specification, means producing something that can be observed by an individual and readily recognized. Throughout the specification, the words "engrave" and "print" are used. As an example, on page 7 of the specification, there is a discussion of printing a positive image on a film that is then fed to a stamp unit. A light emitting unit radiates the stamp material located beneath the stamp body through the original film to optically engrave the image on the stamp material. Thus, the piece of data is recorded in the second format on an output medium that is then used to produce a product. Other descriptions throughout the specification support this definition.

Conversely, in Lemchen, the second format is a set of machine instructions that cannot or are not ever observed or read by a human observer. They are fed directly to a control system that is used to control the production of the item. That is, ideally, in Lemchen, the process is computer controlled and preferably fully automated (col. 4, lines 23-37).

In context, Lemchen does not discuss recording or make recording a part of his description. This is because Lemchen does not have anything truly recorded. The entire procedure is conceived to be done via the Internet because of the interaction required for placing the order (col. 1, lines 26 and 27, and lines 46-54). To say, as was alleged in the interview, that preparing the machine instructions and providing them to the control system constituted recording completely ignores applicants' specification and what recording means in context as used in the claims.

Applicants are entitled to be their own lexicographer and, in this case, Applicants have done so. It is improper to ignore Applicants' definition.

Further, it does not appear that the Lemchen system is intended to operate over a wireless system as found in Applicants' claimed invention and there is no suggestion of such given the complexity of the orders. Thus, there is again no motivation for combining the reference.

Lastly, as admitted in the Office Action, Rubber Stamps, the basic reference doesn't disclose notifying the customer when the product is completed. Further, as the claim is amended, Rubber Stamps does not automatically notify the customer of at least one of receipt of the electronic personalized product producing data and completion of the personalized product requested. To fill this void, the Office Action relies on Harrington which deals with a method of conducting auctions over electronic networks. Harrington discloses a complex auction system that is conducted via computers. When a bid is submitted, and it eventually becomes the winning bid, then there is a notification that the bidder has won the auction. However, this is a very sophisticated system and there is nothing to suggest combining it with any of the other preceding references. None of those references indicate the need to send a confirmation message or a completion message and at least two of those references deal with ordering manufactured products.

Further, to combine this many references, each having a bit or a piece that may equate with a piece of the claimed invention disregards the requirements in the Manual for Patent Examining Procedure which requires both the claimed invention and the references must be considered as a whole and the references must suggest the desirability, and thus, the obviousness of making the combination. Further, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. As the base reference only discloses receiving personalized product producing data in a first format and customer identification information and the rest of the features of the claimed invention are not addressed, but are matters of pure conjecture, then the need to use an additional three

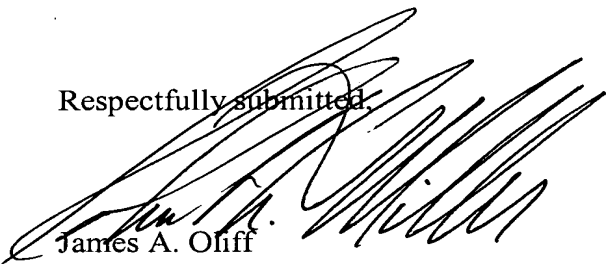
rather disparate references in an effort to find all the claimed features clearly indicates the use of hindsight analysis. As there is nothing to suggest combining the references other than this hindsight analysis, it is respectfully requested that the rejection be withdrawn.

As such, the references do not suggest the subject matter claim 16 for all the reasons discussed above with respect to claim 13 and for the additional features recited therein. Therefore it is respectfully requested the rejection be withdrawn.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of at least 13, 16 and 18-21, claims and preferably all claims 1-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Date: December 16, 2004

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